

REMARKS

The present application was originally filed with claims 1-28. Applicant notes with appreciation the Examiner's indication that claims 4-7 and 9-16 are allowable. With this amendment, claims 1, 4, 17, 19, and 20 have been amended and claims 9, 13, and 22 have been canceled, leaving claims 1-8, 10-12, 14-21, and 23-28 pending in the application. Amended independent claims 1 and 17 more closely conform to allowed claims 4 and 7, and therefore more clearly define over the cited prior art. In view of the amendments and remarks presented herein, reconsideration and allowance of all pending claims are respectfully requested.

The office action asserts a restriction requirement against the application, stating that claims 21-28 are directed to an invention that is independent or distinct from the originally claimed invention. In particular, the office action states that "the combination as claimed does not require the particulars of the subcombination as claimed because [a] layer of filter paper is not required to have a thickness to remove and trap lipids." The office action further states that the subcombination has separate utility, such as "with a coffee maker not requiring a spout for delivery." The office action further alleges that applicant has received an action on the merits for the originally presented invention, and therefore applicant has constructively elected claims 1-20 for prosecution on the merits, thereby withdrawing claims 21-28 from consideration.

Applicant traverses the restriction requirement in view of the claims as amended herein. Independent claims 1 and 17 have been amended to recite "a filter thickness sufficient to effectively remove and trap lipids" from the coffee. Independent claims 4 and 7 already include similar recitations. Accordingly, the filter thickness element cited by the office action as lacking in the combination claims is now present in claims 1-20, and therefore the restriction requirement should be withdrawn and all claims 1-28 should be considered.

Should the Examiner persist in the restriction requirement, applicant notes that the effect of such a position in the official action is that the Patent Office admits that the Group I claims are patentable over a disclosure of the combination of Group II, and *vice versa*. M.P.E.P. § 802.01 states that **the distinctness required for restriction means that the subjects, including “combination and part (subcombination) thereof ... ARE PATENTABLE (novel and unobvious) OVER EACH OTHER”** (emphasis with capital letters in original). (See also M.P.E.P. § 808.02, which states that where “related inventions

are not patentably distinct as claimed, restriction ... is never proper.”) Thus, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the claimed method and devices of the Group I claims are patentable over any disclosure of a filter for use in an espresso-type coffee maker according to the Group II claims. See, e.g., M.P.E.P. § 802.01. Likewise, the effect of this restriction requirement, unless withdrawn, is that the Patent Office admits that the claimed filter of the Group II claims is patentable over any disclosure of the filter devices and methods, according to the Group I claims. *Id.* Each of independent claims 1, 4, 7, 17, and 21 includes similar elements, and therefore such admissions would appear to be improper.

In view of the foregoing, withdrawal of the restriction requirement and consideration of claims 21-28 with claims 1-20 are respectfully requested. To satisfy 37 C.F.R. 1.143, the applicant hereby provisionally elects, with traverse, the claims of Group I, i.e., claims 1-20. In doing so, the applicant does not intend to abandon the scope of the non-elected claims as originally filed, but may pursue the non-elected claims, either by petition for further review or in a divisional application, if the restriction requirement is not withdrawn upon reconsideration.

With regard to the office action comments regarding 37 CFR 1.178, applicant encloses herewith original U.S. Patent No. 6,016,740.

The office action rejects claims 1-20 based on a defective reissue declaration. More specifically, the office action notes that the reissue declaration fails to state that the applicant is the sole owner. Enclosed herewith is a Supplemental Reissue Declaration which includes the appropriate statement at paragraph 2. Withdrawal of this ground of rejection is respectfully requested.

Claim 9 stands rejected under 35 U.S.C. § 112, first paragraph, and 35 U.S.C. § 251 for including new matter. Claim 9 has been canceled, and therefore this ground of rejection should be withdrawn. Applicant notes that claims 13 and 22, which were identical to claim 9 but were not rejected, have also been canceled.

Applicant encloses herewith an Information Disclosure Statement including all of the references cited in the original patent (U.S. Patent No. 6,016,740), as requested in the office action.

Turning to the rejections on the art, claims 1, 8, 17, and 18 have been rejected under 35 U.S.C. § 102(b) as anticipated by Shigenobu et al. (U.S. Patent Application No. 4,506,596). Applicant traverses this rejection.

Independent claims 1 and 17, as amended herein, now specify a filtering device and method that includes a filter having "a filter thickness sufficient to effectively remove and trap lipids" from the coffee. It is not seen that Shigenobu et al. disclose or suggest such

Instead, Shigenobu et al. disclose a beverage brewing apparatus for use in an automatic coffee vending machine. The apparatus includes a brewing cylinder 67 positioned above a "stage" 13, which defines a brewing hole 17, as best shown in FIG. 2. A wire net 20 extends across a top opening 18 of the stage 13. A filter tape 30 extends over the stage 13 and the wire net 20, and is formed of paper, cotton, rayon, or other suitable filter material. A pressurizing piston 80 is slidably fitted in the brewing cylinder 67. In operation, coffee powder is fed into the brewing cylinder 67, and the piston 80 is actuated to pressurize the cylinder 67. Hot water is then fed into the brewing cylinder 67. As the hot water passes through the coffee powder, a coffee solution is percolated. The coffee solution passes through the filter tape 30 and wire net 20 to discharge through the brewing hole 17. Shigenobu et al. fail to disclose or suggest a desired thickness for the filter tape 30, let alone a thickness sufficient to remove and trap lipids, as specified in claims 1 and 17.

Because Shigenobu et al. do not disclose or suggest each of the elements recited by the claims at issue, it follows that the claims are not anticipated thereby. In addition, Shigenobu et al. fail to disclose or suggest that it would be desirable or even possible to provide a filter thickness sufficient to remove and trap lipids, and hence a prima facie case of obviousness has not been established. See In re Sernaker, 217 U.S.P.Q. 1 (Fed. Cir. 1983) and Ex Parte Clapp, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985).

Claims 2-3 and 8 depend from claim 1 and claims 19-20 depend from claim 17, and therefore these claims are similarly patentable over Shigenobu et al. for the reasons presented above.

The office action further rejects claims 2-3 and 19-20 under 35 U.S.C. § 103(a) as obvious over Shigenobu et al. in view of Krebs (U.S. Patent No. 4,052,318). Krebs is relied on solely for teaching a filter having multiple layers. Krebs does not disclose or suggest the removal and trapping of lipids from coffee. Accordingly, for the same reasons presented

above with respect to the rejection of claims 1 and 17, the rejection of claims 2-3 and 19-20 should be withdrawn.

Applicant notes that claim 21, and claims 23-28 dependent directly or indirectly thereon, specify a filter having a layer of paper filter material with a thickness to effectively remove and trap lipids and fine grounds from the brewed coffee and to reduce the trapped lipids in the brewed coffee. Accordingly, claims 21 and 23-28 are allowable over the cited prior art for the same reasons presented above with respect to claims 1 and 17.

Finally, applicant notes that the amendment to claim 4, which has been allowed, simply corrects an obvious error that does not affect the scope of the claim. Entry of this amendment and continued allowance of claim 4 are respectfully requested.

In view of the foregoing amendments and remarks, it is submitted that claims 1-8, 10-12, 14-21, and 23-28 as now appearing in this application are in good and proper form for allowance. A favorable action on the part of the examiner is respectfully solicited.

If, in the opinion of the examiner a telephone conference would expedite prosecution of the subject application, the examiner is invited to call the undersigned attorney.

Respectfully submitted,
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